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26096 7590 10/21/2013 CARLSON, GASKY & OLDS, P.C. 400 WEST MAPLE ROAD SUITE 350 BIRMINGHAM, MI 48009			EXAMINER PRANGE, SHARON M	
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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE PATENT TRIAL AND APPEAL BOARD

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7 *Ex parte* DAN WARREN CLARK and
8 RUSSELL DEAN PARKER

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11 Appeal 2011-012612
12 Application 11/330,988
13 Technology Center 3700
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16 Before JOSEPH A. FISCHETTI, NINA L. MEDLOCK, and
17 THOMAS F. SMEGAL, *Administrative Patent Judges*.

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19 SMEGAL, *Administrative Patent Judge*.

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21 DECISION ON APPEAL

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23 STATEMENT OF THE CASE¹

24
25 Dan Warren Clark and Russell Dean Parker (Appellants) seek review
26 under 35 U.S.C. § 134 of a final rejection of claims 14-21, 23-30 and 32-58,
27 the only claims pending in the application on appeal. We have jurisdiction
28 over the appeal pursuant to 35 U.S.C. § 6(b).

29 We AFFIRM..

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed February 2, 2011) and Reply Brief ("Reply Br.," filed May 20, 2011), and the Examiner's Answer ("Ans.," mailed April 28, 2011).

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THE INVENTION

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The Appellants invented a protective cover for a handheld device
(Specification 1:¶ [2]).

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An understanding of the invention can be derived from a reading of
exemplary claim 14.

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14. A sanitary hand-held nursecall device comprising:

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a hand-held nursecall device having a device shape and a
cord, wherein the cord is attached to a body of the hand-held
nursecall device during use of the hand-held nursecall device by
a user; and

11

12

a shield including:

13

a sheath portion having a sheath shape that
substantially conforms to the device shape of the hand-held
nursecall device, wherein the sheath portion is made of a
flexible, resilient material that blocks biological contaminants
from reaching the hand-held nursecall device, the hand-held
nursecall device is disposed in the sheath portion, and the
sheath portion has a longitudinal axis;

19

20

a bi-directional passage having an open edge that
facilitates insertion and removal of the hand-held nursecall
device into the sheath portion in a direction that is substantially
parallel to the longitudinal axis, wherein the shield is
continuous and openless except for the bi-directional passage;
and

25

26

a sealing device that closes the bi-directional
passage after the hand-held nursecall device has been inserted
into the sheath portion.

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REFERENCES

The Examiner relies upon the following prior art:

Trowbridge	US 4,964,161	Oct. 16, 1990
Uljanic	US 5,092,459	Mar. 3, 1992
Mitchell	US 6,082,535	Jul. 4, 2000

REJECTIONS ON APPEAL

Claims 14-18, 20, 21, 23-30 and 32-58 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Mitchell in view of Trowbridge.

Claim 19 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Mitchell, Trowbridge and Uljanic.

Claims 14-18, 20, 23-30, 32-53, 55, 56 and 58 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Trowbridge in view of Mitchell.

FINDINGS OF FACT

We find that the findings of fact, which appear in the Analysis below, are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

ANALYSIS

The rejection of claims 14-18, 20, 21, 23-30 and 32-58² under 35 U.S.C. § 103(a) as unpatentable over Mitchell in view of Trowbridge.

Claims 14-18, 20, 23-30, 32 and 34-58.

Appellants argue claims 14-18, 20, 23-30, 32 and 34-52 as a group (App. Br. 3-4). We select claim 14 as the representative claim for this group and the remaining claims stand or fall with claim 14. 37 C.F.R. § 41.37 (c) (1) (vii) (2011).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U. S. 398, 406 (2007). It is well established that ordinary creativity is presumed on the part of one of ordinary skill in the art. *Id.* at 421, (“[a] person of ordinary skill is also a person of ordinary creativity, not an automaton.”).

Appellants argue that “[i]f the covering 24 of Mitchell was modified to include the passage 28 of Trowbridge, Jr. as the Examiner contends, the covering 24 would not be free of openings and water-impermeable when the covering 24 is applied as required by Mitchell, destroying the teachings of Mitchell.” (App. Br.4).

We disagree with Appellants because the Examiner found that
“Trowbridge clearly shows that it is conventional to shield a

² While Appellants have appealed from the final rejection that included independent claim 35, both the Appeal Brief and Reply Brief fail to address claim 35 in responding to this final rejection. In that we find this oversight to be a typographical error, we include claim 35 in our decision.

1 communications device which has a cord while it is in use” (Ans. 6). Thus,
2 the Examiner only extracts from Trowbridge “a communications device may
3 have a cord, and that the device may be protected by a cover which seals
4 around the cord while the device is in use.” (Answer 6). The openings
5 which are argued by Appellants are not part of the Examiner’s proposed
6 modification. Nonobviousness cannot be established by attacking the
7 references individually when the rejection is predicated upon a combination
8 of prior art disclosures. *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097
9 (Fed. Cir. 1986).

10 Appellants argue at page 1 of the Reply Brief, further contending that
11 “[i]f the covering 24 of Mitchell was modified to include the passage 28 of
12 Trowbridge, Jr., the bag 26 would not be *completely sealed* due to the
13 presence of the passage 28, destroying the teachings of Mitchell” (emphasis
14 added) (Reply Br. 1).

15 However, this argument is not commensurate with Appellants’ claim,
16 which does not require a shield that is completely sealed, but merely recites
17 “a sealing device that *closes* the bi-directional passage.”

18 For the foregoing reasons, we sustain the Examiner’s rejection of claims
19 14-18, 20, 23-30, 32 and 34-52 as being unpatentable over Mitchell in view
20 of Trowbridge.

21 *Claim 21*

22 We are not persuaded by Appellants’ arguments that the Examiner failed
23 to establish a prima facie showing of obviousness in rejecting claim 21 over
24 Mitchell in view of Trowbridge. We agree with the Examiner that the non-
25 adhesive strip 34 of Mitchell is a backing to which protective covering 24 is

1 removably disposed “as Applicant has defined ‘a backing’ in the claims”
2 (Ans. 9).

3 For the foregoing reason, we sustain the Examiner’s rejection of claim
4 21 as being unpatentable over Mitchell in view of Trowbridge.

5 *Claim 33*

6 As with claim 14, Appellants again argue, “Mitchell discloses that the
7 adhesive 32 completely seals an opening 28” and that elastic 30 of
8 Trowbridge “would not provide a complete seal” (App. Br. 4).

9 Again, this argument is not commensurate with Appellants’ claim 14,
10 from which claim 33 depends, as claim 14 does not require a shield that is
11 completely sealed, but merely recites “a sealing device that closes the bi-
12 directional passage.”

13 For the foregoing reason, we sustain the Examiner’s rejection of claim
14 33 as being unpatentable over Mitchell in view of Trowbridge.

15 *Claims 53 and 56*

16 Appellants argue that the protective cover 24 of Mitchell “is used once
17 and then discarded” (column 2, lines 54 to 59)” (Reply Br.2).

18 Again, Appellants’ argument fails because it is directed to attacking
19 Mitchell separately, even though the rejection is based on the combined
20 teachings of the references. Trowbridge teaches a telephone handset cover
21 “which can be re-used without unduly exposing the user, or subsequent
22 users, to germs that may have been contacted by the cover during a prior use
23 thereof.” *See* column 1, lines 53-56. Furthermore, as the Examiner points
24 out, “[w]ith the adhesive sealing mechanism of Mitchell, only a small
25 portion of the shield is destroyed, while the majority of the shield remains
26 undamaged” (Ans. 10).

1 For the foregoing reason, we sustain the Examiner's rejection of claim
2 33 as being unpatentable over Mitchell in view of Trowbridge.

3 *Claims 54 and 57*

4 Appellants argue that "[t]he width of the bag 26 of Mitchell is constant"
5 (App. Br. 5). The Examiner, however, found and we agree, that because of
6 the adhesive layer 32 (and cover 34), Figure 1 of Mitchell clearly shows the
7 width of the bag 26 must be larger "at a location away from the bi-
8 directional passage" (Ans. 10).

9 For the foregoing reason, we sustain the Examiner's rejection of claims
10 54 and 57 as being unpatentable over Mitchell in view of Trowbridge.

11 *Claims 55 and 58*

12 Appellants argue "[b]oth of these references relate to a phone or pager"
13 (App. Br. 5 and Reply Br. 3). Again we agree with the Examiner that
14 "[b]oth are devices which are held in the hand and are capable of calling a
15 nurse" (Ans. 11).

16 For the foregoing reason, we sustain the Examiner's rejection of claims
17 55 and 58 as being unpatentable over Mitchell in view of Trowbridge.

18 *The rejection of claim 19 under 35 U.S.C. § 103(a) as unpatentable over*
19 *Mitchell, Trowbridge and Uljanic.*

20 Appellants continue to argue Mitchell separately, contending that "to
21 adapt the bag 26 of Mitchell to include elevations over the controls as taught
22 in Uljanic...the elevations would be eliminated once the bag was shrinked"
23 (Reply Br. 3). As pointed out before, Appellants' argument fails because it
24 is directed to attacking Mitchell separately, even though the rejection is
25 based on the combined teachings of the references. Furthermore, the
26 Examiner found, and we agree, that "shrinking a bag with defined elevations

1 would not cause the elevations to disappear; it would merely shrink the
2 elevations to a smaller size” (Ans. 11).

3 *The rejection of claims 14-18, 20, 23-30, 32-53, 55, 56 and 58 under 35*
4 *U.S.C. § 103(a) as unpatentable over Trowbridge in view of Mitchell.*

5 We are persuaded that the Examiner failed to establish a prima facie
6 showing of obviousness in rejecting claims 14-18, 20, 23-30, 32-53, 55, 56
7 and 58 over Trowbridge in view of Mitchell. The Examiner contends that it
8 would have been obvious “to have made the shield of Trowbridge
9 continuous, as taught by Mitchell” (Ans. 8), because “the filter elements 68
10 and 70 *are capable of being attached* to the cover 20 without the holes 50
11 and 52 (such as with adhesive) (emphasis added) (Ans. 11-12). However, as
12 Appellants’ correctly observe, “[i]n Trowbridge, Jr., the cover 20 is not
13 continuous and openless as it includes holes 50 and 52 into which filter
14 elements 68 and 70 are located (column 3, lines 36 to 45)” (Reply Br. 4).
15 For this reason, the rejection of 14-18, 20, 23-30, 32-53, 55, 56 and 58 using
16 Trowbridge as a base reference is not sustained.

17
18 DECISION

19 The decision of the Examiner to reject claims 14-18, 20, 21, 23-30
20 and 32-58 over Mitchell in view of Trowbridge is sustained.

21 The decision of the Examiner to reject claim 19 over Mitchell and
22 Trowbridge in view of Uljanic is sustained.

23 The decision of the Examiner to reject claims 14-18, 20, 23-30, 32-53,
24 55, 56 and 58 over Trowbridge in view of Mitchell is reversed.

Appeal 2011-012612
Application 11/330,988

1 No time period for taking any subsequent action in connection with this
2 appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.
3 § 1.136(a)(1)(iv) (2011).

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AFFIRMED

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